UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,742	08/13/2001	Falko Tesch	30014200-1012	9030

			EXAMINER
26263	7590	06/02/2005	NGUYEN BA, PAUL H

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ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/929,742	TESCH ET AL.
	Examiner	Art Unit	
	Paul Nguyen-Ba	2176 ·	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3/17/2005*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28,31-33 and 36-38* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28,31-33 and 36-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1.   This action is responsive to Applicant's Amendment filed on 3/17/2005.

2.   Claims 1-28, 31-33, 36-38 have been considered. Claims 1, 7, 8, 9, 10, 11, 17, 18, 19,

20, 25, 26, 31, 36, 37, and 38 are independent claims.

Priority

3.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers

have been placed of record in the file.

4.   This application clams benefit of provisional patent application 60/296,095 under 35

U.S.C. 119(e).

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 1-5, 7-15, 17-19, 25-28, 30-33, 35 are rejected under 35 U.S.C. 102(b) as being

anticipated by Oracle Forms ® Advanced Techniques ("Oracle"), Ch. 10, pgs. 1-18, © 1996

Oracle Corporation (*available at* http://mates.ms.mff.cuni.cz/oracle/doc/forms45/at/ch10.htm).

Independent Claims 1, 7, 9, 10, 11, 17, 19, 25 and Dependent Claims 2-5, 12, 14, 15

Oracle teaches a method and computer readable medium in a data processing system for processing a document containing an embedded object having a first format corresponding to a first program (i.e. OLE) (see pgs. 2-3), the method comprising the steps of:

automatically determining whether the first program is an unavailable program (see pg. 17, heading: Converting OLE Objects – 1st paragraph → OLE object conversion is used for editing OLE objects when the OLE server application that originated an OLE object is **not available**);

when it is determined that the first program is an unavailable program, converting the embedded object into a second format different from the first format that is suitable for use with a second program that is available on the data processing system (see pg. 17 and 18, headings: Converting OLE Objects and Converting Embedded Objects → the "Convert To" command permanently alters the format of the object to the selected type for *automatic identification* of the selected type);

receiving an indication of a third format from a user (see pg. 18, step 3);

converting the embedded object into the third format (see pg. 18, step 4); and

storing the embedded object in the third format (see pg. 18, step 5).

Claim 13

Oracle teaches *determining which of the plurality of programs are available on the data processing system* (see pg. 18, step 3) and *displaying the associated formats of the available programs to a user* (see Figure on pg. 17).

Independent Claims 8, 18, 26, 31 and Dependent Claims 27, 32

Oracle teaches a method in a data processing system containing a plurality of programs, each with an associated format, the data processing system for processing a document containing an embedded object having an originating format corresponding to an originating program (i.e. OLE) (see pgs. 2-3), the method comprising the steps of:

automatically determining whether the originating program is unavailable (see pg. 17, heading: Converting OLE Objects – 1st paragraph → OLE object conversion is used for editing OLE objects when the OLE server application that originated an OLE object is **not available**);

when it is determined that the originating program is unavailable, determining which of the plurality of programs are available on the data processing system (see pg. 18, step 3),

displaying the associated formats of the available programs to a user (see Figure on pg. 17), and

receiving an indication of a selected one of the displayed formats from the user (see pg. 18, step 3); and

converting the embedded object into the selected format (see pg. 18, step 4);

while the document is being loaded into memory (see pgs. 17 and 18).

Claims 28 and 33

Oracle teaches *retrieving the indication from storage* (see pg. 17 and 18, specifically step 5 → the "Convert To" command permanently alters the format of the object to the selected type for *automatic identification* of the selected type and is stored and recalled from storage).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 6, 16, 20, 21, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Oracle Forms ® Advanced Techniques ("Oracle"), Ch. 10, pgs. 1-18, © 1996 Oracle

Corporation (*available at* http://mates.ms.mff.cuni.cz/oracle/doc/forms45/at/ch10.htm), in view

of Francis et al. ("Francis"), U.S. Patent No. 6,182,092.

Claims 6 and 16

Oracle teaches the method and computer readable medium of independent claims 1 and

11, but does not specifically teach converting the embedded object into an intermediate format.

However, Francis teaches converting OLE documents and objects into an intermediate

format as a preprocessing step (see Fig. 6 and col. 14, lines 24-40) for the purpose instantiating

the output, and hence, smoothing the transition between different formats.

It would have been obvious at the time the invention was made to a person having

ordinary skill in the art to modify the teaching of Oracle with the teachings of Francis to include

converting the embedded object into an intermediate format for the purpose instantiating the

output, and hence, smoothing the transition between different formats.

Independent Claim 20 and Dependent claim 21

Oracle teaches a method and computer readable medium in a data processing system for

processing a document containing an embedded object having a first format corresponding to a

first program (i.e. OLE) (see pgs. 2-3), comprising the steps of:

determining whether the first program is an unavailable program (see pg. 17, heading:

Converting OLE Objects – 1st paragraph);

when it is determined that the first program is an unavailable program, converting the

embedded object into a second format different from the first format that is suitable for use with

a second program that is available on the data processing system (see pg. 17 and 18, headings:

Converting OLE Objects and Converting Embedded Objects), and

storing the format of the embedded object (see pg. 18, step 5).

Oracle does not specifically teach a first or second identifier wherein the second identifier

can replace the first identifier. However, Francis teaches the use of identifiers to identify

objects of a format embeddable in the document (see col. 2 lines 52-53 and col. 4 39-67 *et seq.*)

for the purpose of associating and identifying different embedded objects in a document.

Furthermore, it is well known to those of ordinary skill in the art that a first identifier can be

replaced by a second identifier for the purpose of converting a first object format into a second

object format.

Claim 22

See the rejection of independent claim 1.

Claims 23 and 24

Please refer to the rationale relied upon to reject independent claim 1.

9.   Claims 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oracle

Forms ® Advanced Techniques ("Oracle"), Ch. 10, pgs. 1-18, © 1996 Oracle Corporation

(*available at* http://mates.ms.mff.cuni.cz/oracle/doc/forms45/at/ch10.htm), in view of Laverty et

al. ("Laverty"), U.S. Patent No. 6,396,593.

Claims 36-38

Oracle teaches the method, system, and computer-readable medium with respect to

independent claim 1 as discussed above, but does not specifically teach selecting a user

selectable setting comprising at least a first setting for performing the step of converting while

the document is being loaded into memory and a second setting for performing the step of

converting upon selection of the document for editing.

However, Laverty teaches user selectable conversion settings (see col. 6 lines 38-40) for

the motivational purpose of allowing the human user to intervene, oversee, and drive all steps in

the conversion process. It would have been obvious at the time the invention was made to a

person having ordinary skill in the art to modify the teaching of Oracle with the teachings of

Laverty to include a choice of settings for performing the step of converting at various points of

the conversion process for the motivational purpose of allowing the human user to intervene,

oversee, and drive all steps in the conversion process.

Response to Arguments

10.   Applicant's arguments filed 3/17/2005 have been fully considered but they are not

persuasive.

Applicant first contends that Oracle does not disclose "automatically determining

whether the first program is an unavailable program." Applicant explains his contention as

follows:

"Oracle teaches that when an application that originated an OLE object is not available,

it may be possible to convert the OLE object to another format. To do so, Oracle states that the

user must "move the cursor on the OLE container" (see pg. 17, step 1) and then "use the right

mouse button to access the OLE popup menu" (see pg. 18, step 2) to choose the Convert option

(see pg. 18, step 2). Thus, Oracle requires that the user manually choose and object and then

initiate the conversion program."

"Thus, unlike in the cited art, the present invention does not require the user themselves

to manually determine whether the first program is available and that conversion to a different

format is required."

Examiner respectfully disagrees. First, Examiner notes that Applicant's argument tends

to be directed and more applicable to 'automatically converting an unavailable program's

format' as opposed to 'automatically determining whether a program is unavailable.' However, the pending claims, as amended, only have the term "automatically" modifying the first limitation regarding determining a program's availability. If Applicant's intention was to have the term "automatically" pertain particularly to the conversion process, a further search would indeed be required.

However, the pending claims, as they currently stand, are taught by Oracle. Normally, activating an OLE object causes the OLE server application that originated the OLE object to start up. When an object is not available, it is, in essence, automatically determined by the Oracle system because the OLE server application would not be accessible for editing an embedded or linked object without OLE object conversion (see pg. 15 – 1st two paragraphs). This triggered response exists through operation of a preexisting arrangement in the Oracle system with minimal human intervention. Another exceptional application of this determination can be found and is well known in Microsoft Windows. When attempting to run an application wherein a program is not available, a pop up appears with a list of alternative programs to apply to said application.

Applicant further contends that Oracle does not disclose "while the document is being loaded, determining whether the first program is unavailable." Applicant contends that Oracle teaches only that after a program is loaded, a user may manually choose to initiate a conversion.

Examiner respectfully disagrees. Oracle determines whether a program is unavailable during the loading process. The loading process entails that a program must be copied into memory before execution. It is during the process of loading the program into memory and

before the execution of the program that the Oracle system determines whether a program is

available or not. The conversion of said object into an acceptable format is the final bits of data

required to be loaded to memory in order to run the executable.

Finally, Applicant contends that Francis does not teach or even suggest that an embedded

object may include a second identifier to identify a program. Examiner respectfully disagrees.

Francis teaches the use of identifiers to identify objects of a format embeddable in the

document (see col. 2 lines 52-53 and col. 4 lines 39-67 *et seq.*) for the motivational purpose of

associating and identifying different programs. It is Examiner's opinion that one of ordinary

skill in the art at the time the invention was made would be motivated to combine Francis and

Oracle for the purpose of associating and identifying a program to be used for accessing the

embedded data when the original program is not available.

11.   Applicant's arguments with respect to claims 36-38 have been considered but are moot in

view of the new ground(s) of rejection.

Conclusion

12.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action.. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094.

The examiner can normally be reached on 10 am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER